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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,239	06/09/2000	Yoshihiro Hirano	P/2007-63	3197
7590 11/04/2003			EXAMINER	
Steven I Weisburd Esq Dickstein Shapiro Morin & Oshinsky LLP 1177 Avenue of the Americas- 41st Floor New York, NY 10036-2714			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/591,239	Applicant(s) HIRANO ET AL.	
	Examiner Callie E. Shosho	Art Unit 1714	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): double patenting rej., 103 rejection utilizing JP 07124913.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: 14.

Claim(s) rejected: 6-13.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Callie E. Shosho
Primary Examiner
Art Unit: 1714

Attachment to Advisory Action

1. Applicants' response filed 10/14/03 has been fully considered.

It is noted that applicants filing of a terminal disclaimer on 10/14/03 overcomes the double patenting rejection of record.


Applicants' response overcomes the 35 USC 103 rejection of record utilizing JP 07124913 as set forth in paragraph 6 of the office action mailed 5/13/03.

However, applicants' response is not successful in overcoming the 35 USC 103 rejection of record utilizing JP 61066604 as set forth in paragraph 5 of the office action mailed 5/13/03.

JP 61066604 discloses a method of manufacturing ligneous material comprising mixing first wood elements which are 15-20% acetylated and second wood elements which are not acetylated to form third wood elements and then binding the third wood elements with phenolic binder. It is further disclosed that the first wood elements are acetylated by being brought into contact with liquid that contains acetyl groups.

Previously examiner argued that while JP 61066604 discloses the degree of acetylation in terms of percentage acetylated OH groups and the present claims require degree of acetylation measured in weight percent gain, given that JP 61066604 disclose forming the acetylated first wood element by a process identical to that presently claimed, i.e. acetylating by placing the wood elements in liquid which contains acetyl groups and further given that JP 61066604 disclose the same acetylating agent as utilized in the present invention, i.e. acetic anhydride, it is clear, absent evidence to the contrary, that the wood elements of JP 61066604 would intrinsically be acetylated to the same degree, as measured in weight percentage gain, as the presently claimed wood elements.

In response, applicants argue that since examiner has stated that percentage acetylated hydroxyl groups is not equivalent to the percentage of weight gain, JP 61066604 cannot inherently teach average degree of acetylation in the range of 7-18% as presently claimed. Applicants also argue that the examiner must provide a basis to support the determination of inherency.

It is noted that JP 61066604 discloses first wood elements that are acetylated but measures the degree of acetylation in a different manner than presently claimed, i.e. percentage acetylated hydroxyl group as opposed to percentage weight gain. However, acetylating 15-20% of the hydroxyl groups present on the wood elements would obviously result in a certain weight gain. That is, the wood elements having 15-20% acetylated OH groups are not precluded from having degree of acetylation measured in weight percent gain of 7% or greater. Although it is agreed that percentage acetylated hydroxyl groups is not equivalent to the percentage of weight gain, this doesn't mean that the wood elements cannot or do not possess degree of acetylation in terms of weight percent gain as presently claimed. It is the examiner's position  that since JP 61066604 disclose forming the acetylated wood elements by process identical to that presently claimed, it is clear, absent evidence to the contrary, that the wood elements of JP 61066604 would intrinsically be acetylated to the same degree as presently claimed. In light of this position and given that JP 61066604 disclose amounts of first wood elements and second wood elements (not acetylated) as presently claimed, the average degree of acetylation would also necessarily intrinsically be the same as presently claimed.

Applicants argue that the examiner has no basis for the above position. But it is noted that examiner's position is based on the fact that JP 61066604 discloses forming the acetylated first

wood element by a process identical to that presently claimed, i.e. acetylating by placing the wood elements in liquid which contains acetyl groups and further given that JP 61066604 disclose the same acetylating agent as utilized in the present invention, i.e. acetic anhydride.

Applicants also argue that Terada et al. is not a relevant reference against the present claims given that Terada et al. do not disclose acetylation of wood fibers as presently claimed.

However, note that Terada et al. is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely that the use of a binder which is a combination of phenolic resin and polyisocyanate with wood elements is advantageous in terms of strength as opposed to the use of phenolic resin or polyisocyanate alone, and in combination with the primary reference, discloses the presently claimed invention.

Further, applicants' are reminded that according to MPEP 2141.01 (a), a reference may be relied on as a basis for rejection of an applicants' invention if it is "reasonably pertinent to the particular problem with which the inventor is concerned." A reasonably pertinent reference is further described as one which "even though it maybe in a different field of endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." Terada et al. is, therefore, a reasonably pertinent reference, because it teaches that using binder which is a combination of phenolic resin and polyisocyanate produces wood element with more satisfactory strength than using either

phenolic resin or polyisocyanate alone, which is a function especially pertinent to the invention at hand.

NOTE: Given that applicants response filed 10/14/03 overcomes the rejection of record utilizing JP 07124913, claim 14 is now objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. There is no disclosure or suggestion in JP 61066604 that the first wood elements have diameter of 0.1 to 1 mm as required in claim 14.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
10/30/03